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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/787,130	02/27/2004	Naoyuki Ezuka	Q80148	4669

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EXAMINER

ALIMENTI, SUSAN C

ART UNIT PAPER NUMBER

3644

DATE MAILED: 03/13/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary	Application No.	Applicant(s)	
	10/787,130	EZUKA, NAOYUKI	
	Examiner	Art Unit	
	Susan C. Alimenti	3644	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 09 January 2006.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-16 is/are pending in the application.
- 4a) Of the above claim(s) 5,6 and 14 is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-4, 7-13, 15 and 16 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|---|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892) * | 4) <input type="checkbox"/> Interview Summary (PTO-413) |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | Paper No(s)/Mail Date. _____ |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

Claim Rejections - 35 USC § 112

1. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

2. Claims 1-4 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention. Claim 1 recites, "a grip portion. . . is fixed to through the concealing film." This phrase is awkward, confusing and it is difficult to decipher exactly what structure applicant is attempting to claim.

Claim Rejections - 35 USC § 102

3. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

4. Claims 7-9 are rejected under 35 U.S.C. 102(b) as being anticipated by Yamamoto et al. (US 5,048,223).

Yamamoto et al. '233 (Yamamoto '233) discloses a fishing reel comprising a rod pipe 11 that is inserted into a reinforced tubular body 12, and a synthetic resin body 13, 14 (col.4, lns.41-48) that is integrally molded with an outer side of the tubular body 12, at portion 12e.

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5. Claims 7-11, 13, and 16 are rejected under 35 U.S.C. 102(b) as being anticipated by Yamamoto et al. (US 6,105,302).

Yamamoto et al. '302 (Yamamoto '302) discloses a fishing reel, as best viewed in Figures 1, 2, and 11, comprising a rod pipe 1, a reinforced tubular body 2 made of a reinforced synthetic resin (col.3, lns.45-50), and a synthetic resin body 42, 43 which is integrally molded to an outside of the tubular member 2. The synthetic resin body is disclosed as optionally being made of a synthetic resin (col.4, ln.37), or a foamed resin material (col.3, lns.63-64), both of which are softer than the reinforced pre-impregnated resin of the tubular member 2.

Regarding claims 8 and 9, the tubular body is inside member 42 of the resin body and is projected or extends in an axial direction of the tubular body.

Regarding claim 10, the tubular body 2 is made from a fiber reinforced plastic.

Regarding claim 11, member 41 is optionally made from a foamed material, artificial cork, or natural cork (col.3, lns.63-64).

Regarding claim 13, a reel mount is meant to fit inside portion 43 of the resin body (Figure 6).

Claim Rejections - 35 USC § 103

6. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

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7. Claims 1-4, 12, and 15 are rejected under 35 U.S.C. 103(a) as being unpatentable over Yamamoto '302 as applied to claims 7-11, 13, and 16 above, and further in view of Wallace (US 3,778,916).

Yamamoto '302 discloses the claimed invention except it is not positively disclosed whether the material that make up the device are colored, opaque, transparent, translucent, etc. Wallace discloses a fishing rod having a handle that he teaches may be made of colored or transparent material for decorative purposes (Wallace, col.1, lns.59-63). It would have been obvious to one having ordinary skill in the art at the time the invention was made to use a transparent or translucent material as an obvious design choice in creating a preferable aesthetic appearance.

Regarding the concealing film and cover member recited in claims 3 and 12, Yamamoto '302 discloses that the trigger portion 43a maybe made separable and attached by means of an adhesive (Yamamoto '302, col.4, lns.41-44). Said adhesive is readable on the limitation of a concealing film and trigger portion 43a is considered to be the cover member for covering a face portion of the resin body where the concealing film is formed.

Response to Arguments

8. Applicant's arguments filed 09 January 2006 have been fully considered but they are not persuasive.

First regarding Yamamoto '233 and the rejection of claim 7, applicant contends that Yamamoto does not positively disclose that synthetic body (grip 13) is integrally molded to an outer side of tubular body 12. The examiner respectfully disagrees, and asserts that the

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connection between the two elements at side 12e (Figure 2), satisfies the metes and bounds of this claim.

Further, applicant reads to narrowly the **broad** limitation of claims 1 and 7, which states, “a synthetic resin body *integrally molded* with an outer side of the tubular body” (emphasis added), and attempts to apply procedural steps to what is an apparatus claim. So long as the structure is present in the prior art, the claim is satisfied. It is noted that Yamamoto ‘233 and ‘302 may not positively discuss how the synthetic resin is molded to the shape of the respective tubular bodies. Generally, polymers and synthetic materials are molded to a desired shape and in the Yamamoto references the designated synthetic bodies were molded to a form with the tubular bodies a one-piece, integral handgrips. It is clear from the Figures in each patent that the designated synthetic bodies conform completely to the outer sides of the designated tubular bodies, and assure a seal between the two elements preventing water, dust, or dirt to enter in between the two.

In response to applicant's arguments against the combination of the Yamamoto ‘302 & Wallace references, one cannot show nonobviousness by attacking references individually where the rejections are based on combinations of references. See *In re Keller*, 642 F.2d 413, 208 USPQ 871 (CCPA 1981); *In re Merck & Co.*, 800 F.2d 1091, 231 USPQ 375 (Fed. Cir. 1986). In the present case, Wallace is provided only as a teaching for using a transparent material as a grip on a fishing rod, *not* for the structure of said grip. It is maintained that Wallace properly teaches this feature, and Yamamoto ‘302 teaches the claimed structure.

Conclusion

9. **THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire **THREE MONTHS** from the mailing date of this action. In the event a first reply is filed within **TWO MONTHS** of the mailing date of this final action and the advisory action is not mailed until after the end of the **THREE-MONTH** shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than **SIX MONTHS** from the mailing date of this final action.

10. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Susan C. Alimenti whose telephone number is 571-272-6897. The examiner can normally be reached on Monday-Friday, 9am-5pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Teri Luu can be reached on 571-272-7045. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

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11. Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

Susan C. Alimenti

A handwritten signature in black ink, appearing to read 'Teri Pham Luu', with a stylized flourish at the end.

**TERI PHAM LUU
SUPERVISORY
PRIMARY EXAMINER**